In the Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-584

MARY HELEN SEARS, PETITIONER

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

Pursuant to the Freedom of Information (FOI) Act, 5 U.S.C. 552, petitioner requested disclosure by the Patent Office of all of the approximately 600,000 abandoned United States patent applications. The request was denied on the ground that the material was "specifically exempted from disclosure by statute," within the meaning of exemption 3 of the FOI Act, 5 U.S.C. 552(b)(3), because 35 U.S.C. 122 requires that "[a]pplications for patents shall be kept in confidence."[1]

[1] 35 U.S.C. 122 provides:

> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

Exemption 3 of the FOI Act, 5 U.S.C. 552(b)(3), provides:

> (b) This section does not apply to matters that are—
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> * * * * *
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> (3) specifically exempted from disclosure by statute;
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Petitioner thereupon brought this suit under the FOI Act seeking disclosure of the abandoned patent applications and, if public access to the applications were deemed barred by 35 U.S.C. 122, a declaration that Section 122, as well as 37 C.F.R. 1.14(b) and 1.108, were unconstitutional.[2] Petitioner also sought a court order directing the Commissioner of Patents to consider abandoned United States patent applications in the examination of pending applications. The district court denied relief, holding (1) that abandoned patent applications were exempt from disclosure by virtue of 35 U.S.C. 122 and exemption 3 and (2) that "[t]he Patent Office has not been citing forfeited and abandoned applications as references since December of 1879 * * * 'and we are not disposed to disturb * * * [the rule]' " (Pet. App. B, pp. 22a-25a).[3]

On petitioner's appeal, the court of appeals affirmed on the ground that abandoned patent applications were protected from disclosure by exemption 3 (Pet. App. A, pp. 6a-16a). The court held that the Commissioner's authority under Section 122 to permit disclosure in "special circumstances" did not except that section from exemption 3 (Pet. App. A, pp. 6a-8a).[4] The court ruled, further, that

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[2]The district court denied a request by petitioner to convene a three-judge court.

[3]The district court also held that the documents contained trade secrets and confidential commercial and financial information and were exempt from disclosure pursuant to exemption 4 (Pet. App. B, p. 22a). The court ruled, further, that the request for disclosure of 600,000 abandoned patent applications was not a request for "identifiable records" as required by 5 U.S.C. 552(a)(3) (Pet. App. B, pp. 21a-22a).

[4]The court, in reliance upon the legislative history of Section 122, ruled that it requires confidential treatment for both pending and abandoned applications (Pet. App. A, pp. 11a-16a).

Section 122, and 37 C.F.R. 1.14(b) and 1.108 are not unconstitutional, stating that "plaintiff's constitutional contentions are lacking in merit, and indeed are so insubstantial that it was unnecessary to convene a three-judge court pursuant to 28 U.S.C. §2282 to reject them" (Pet. App. A, p. 16a).[5]

1. This Court, on December 16, 1974, granted the petition for a writ of certiorari in *Butterfield v. Robertson,* No. 74-450, to review the question whether exemption 3, which exempts material that is "specifically exempted from disclosure by statute," 5 U.S.C. 552(b)(3), covers "all material with respect to which Congress by statute has provided for nondisclosure upon various terms, including statutes that give government officials discretion to decide whether to disclose" (Pet. No. 74-450, p. 2). Contrary to petitioner's assertion (Pet., pp. 18-21), review of the instant case will not aid in the decision of that question.

The government contended in its petition in *Robertson* that Congress intended by exemption 3 to preserve all nondisclosure statutes, regardless of their terms, which specifically provide for nondisclosure. As we pointed out in our reply memorandum in *Robertson,* "the issue presented in our petition broadly involves the scope of exemption 3 itself and not merely its application to the particular confidentiality statute involved in this case" (p. 1). Since the focus of *Robertson* is on the meaning of exemption 3 generally, rather than the specific nondisclosure statute involved, review of an additional case involving a different nondisclosure statute will not assist this Court in its determination of the issue in *Robertson.*

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[5]The court of appeals held that petitioner had requested "identifiable records," but found it unnecessary to reach the additional rulings of the district court relating to exemption 4 (see n. 3, *supra,* p. 2).

Moreover, 35 U.S.C. 122 is within the scope of exemption 3, even under the court of appeals' narrow construction of that exemption in *Robertson* v. *Butterfield,* 498 F.2d 1031. In *Robertson,* the court of appeals stated that "[t]he ordinary meaning of the language of Exemption (3) is that the statute therein referred to must itself specify the documents or categories of documents" (498 F.2d at 1032). Since Section 122 refers to a specific category of documents, namely, "applications for patents," the District of Columbia Circuit apparently would conclude that the section comes within exemption 3.[6]

Although there is conflict among the circuits over whether 49 U.S.C. 1504 and 42 U.S.C. 1306(a) are within the scope of exemption 3 (see Pet. No. 74-450, pp. 16-17; Reply Memo, No. 74-450, p. 2), nothing in the decisions of the various courts of appeals suggests that any of them would reach a result different than that reached by the Fourth Circuit Court of Appeals in this case. Since the decision of the court of appeals here is correct under even the most restrictive reading of exemption 3, further review by this Court of the applicability of the exemption here is not warranted.

2. Petitioner's other questions presented, in essence, ask this Court to declare that the Patent Office must consider abandoned patent applications in its examination of pending applications. This case, however, involves only a request under the FOI Act for abandoned patent applications and does not present in a concrete factual setting, or a true adversary context, the issue whether the Patent Office must consider abandoned patent applications during its patent examinations. The declaration which the petitioner

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[6]The contention of petitioner that the category of "applications for patents" in Section 122 is as specific as the class of "any * * * information obtained by the * * * [Federal Aviation] Administrator," 49 U.S.C. 1504, is unsound on its face (Pet., p. 21, n. 31).

seeks, therefore, would constitute an advisory opinion, which the courts are without power to issue.[7] *United States* v. *Richardson*, No. 72-885, decided June 25, 1974 (slip op., pp. 4-5).

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

DECEMBER 1974.

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[7]Petitioner contends that abandoned applications are "necessary to carry out the provisions" of 35 U.S.C. 102 and 103 and thus are not within the purview of 35 U.S.C. 122. The legislative history set forth in the court of appeals' opinion (Pet. App. A, pp. 11a-15a), however, shows that Congress intended Section 122 to include abandoned patent applications. See also *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470, 485.

The court of appeals properly rejected as insubstantial petitioner's assertion that the Patent Clause of the Constitution, Art, I, §8, Cl. 8, requires the consideration by the Patent Office of abandoned applications in the examination of pending applications (Pet. App. A, pp. 16a-18a).